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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/061, 417      04/16/98      OLSON

E      UTSO: 548

HM12/1121

EXAMINER

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ART UNIT	PAPER NUMBER
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1642

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DATE MAILED:

11/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/061,417

Applicant(s)

Examiner

Group Art Unit

1642

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### P r i o r i t y Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- Responsive to communication(s) filed on 08/02/00.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 1-40 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) \_\_\_\_\_ is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) 1, 2, 4, 6, 7, 9-11 are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Pri ority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Acti n Summary

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## **DETAILED ACTION**

Applicant's election of group I, claims 1,2, 4, 6, 7 and 9-11 in paper No:12, is acknowledged.

After review and reconsideration, the restriction requirement for group I, claims 1,2, 4, 6, 7 and 9-11 in the Office action of paper No: 8, on 01/20/00 is vacated. The following is the new restriction requirement for claims 1,2, 4, 6, 7 and 9-11.

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I.I. Claims 1, 2, 7, drawn to a method for treating hypertrophy in a cardiomyocyte cell using cyclosporin A to inhibit dephosphorylation of NF-AT3, classified in class 514, subclass 2.
  - I.II. Claims 1, 2, 7, drawn to a method for treating hypertrophy in a cardiomyocyte cell using FK506 to inhibit dephosphorylation of NF-AT3, classified in class 514, subclass 2.
  - I.III. Claims 1 and 6, drawn to a method for treating hypertrophy in a cardiomyocyte cell by inhibiting the interaction of NF-AT3 with GATA4, classified in class 514, subclass 2.

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I.IV. Claims 1, 4, 9-11, drawn to a method for treating hypertrophy in a cardiomyocyte cell using an antibody to bind to NF-AT3 and to inactivate NF-AT3, classified in class 424, subclass 130.1.

I.V. Claims 1, 4, and 9, drawn to a method for treating hypertrophy in a cardiomyocyte cell using a small molecule to inactivate NF-AT3, classified in class 514, subclass 2.

2. The inventions are distinct, each from the other because of the following reasons:

The methods of groups (I-II), (III), and (IV-V) are patentably distinct because they use different reagents and different mechanisms for treating hypertrophies, i.e. by inhibiting dephosphorylation of NF-AT3, versus inhibiting the interaction of NF-AT3 with GATA4 which is a transcriptional factor, or inactivating the activity of NF-AT3. Furthermore, the reagents of groups I and II are distinct from each other because they are structurally distinct. Similarly, the reagents of groups IV and V are distinct from each other because they are structurally distinct.

Because these inventions are distinct for the reason given above and have acquired a separate status in the art, and because the searches for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

Applicants are required under 35 USC 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Tam B. Davis whose telephone number is (703) 305-2008. The examiner can normally be reached on Monday-Friday from 9:30am to 3:30pm, except on Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Caputa, can be reached on (703) 308-3995. The fax phone number for this Group is (703) 308-4227.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0916.

Minh-Tam B. Davis

November 11, 2000

*M*  
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